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OFFICE OF PETITIONS

In re Application of
Hoffmann
Application No.: 09/820,146
Filing Date: 28 March, 2001
Attorney Docket No. Hoffmann 3

DECISION

This is a decision on the petition filed on 25 October, 2007, to revive an application under 37 C.F.R. §1.137(b) as having been abandoned due to unintentional delay.

The Office regrets the delay in addressing this matter, however, the instant petition was presented to the attorneys in the Office of Petitions only at this writing.

PLEASE NOTE:

Once again Petitioner is reminded that papers previously submitted with as to revocation/power of attorney have not been entertained by the Office because Petitioner steadfastly has refused (apparently since November 2003) to comply with Office requirements for signature by an authorized officer of the averred assignee and a certificate under 37 C.F.R. §3.73(b).

Thus, there is no satisfactory indication that Petitioner herein was ever empowered to prosecute the instant application.

If Petitioner desires to receive future correspondence regarding this application, the appropriate power of attorney documentation must be submitted.

A courtesy copy of this decision will be mailed to Petitioner.

However, all future correspondence will be directed to the address of record until such time as appropriate instructions are received to the contrary.

Application No.: 09/820,146

The petition under 37 C.F.R. §1.137(b) is GRANTED.

As to the Allegations
of Unintentional Delay

The requirements of a grantable petition pursuant to 37 C.F.R. §1.137(b) are the petition and fee therefor, a reply, a proper statement of unintentional delay under the regulation, and, where applicable, a terminal disclaimer and fee. (However, it does not appear that a terminal disclaimer and fee are due here.)

It appears that Petitioner has satisfied the requirements of the regulation, as set forth below:

BACKGROUND

The record reflects that:

Petitioner failed to reply timely and properly to a non-final Office action mailed on 10 January, 2006, with reply due absent extension of time on or before 10 April 2006.

The application went abandoned by operation of law after midnight 10 April, 2006.

The Office mailed the Notice of Abandonment on 10 October, 2006.

On 13 November, 2006, Petitioner submitted a petition (averring unavoidable delay) and fee, an amendment (which the Examiner has indicated will be entered), and made a statement of unavoidable delay—averring therein that while Petitioner filed a Revocation/Power of Attorney and Change of address on 17 November, 2003, it appears that the Office did not enter that information of record. The record further reflects that, following filing of the application, a Revocation/Power of Attorney was submitted on 31 January, 2003, and thereafter, resubmitted on 16 April, 2003, over the signatures of officers (Corporate Counsel and Managing Corporate Counsel) of the Assignee. The instruction set forth there was honored by the Office, and the Harness Dickey address was entered. However, the Office did not enter a paper filed by Petitioner in November 2003—because the Revocation/Power of Attorney submitted on 17 November, 2003, was signed not by an appropriate officer of the Assignee, but by one of the interim-appointed attorneys. (The Rules of Practice (37 C.F.R. Part 1) and the Commentary set forth in the Manual of Patent Examining Procedure (MPEP) speak to the revocation of power from and appointment of attorneys and agents by an applicant/patentee or the assignee of the entire interest in the application. (See: 37 C.F.R. §1.36 and MPEP §204.05 and §204.07)—but not to such authority by an attorney appointed in the interim.) Moreover—and notably—while the

papers mailed by the Office in this matter on 2 July, 2004, on 21 September, 2004, on 21 April, 2005, and on 11 July, 2005, all were addressed to prior Counsel, they nonetheless appear to have reached Petitioner, who replied thereto. Thus, Petitioner appeared to have taken no action of record to Notice or otherwise diligently and with due care properly inform the Office or otherwise to re-advance its Revocation/Power of Attorney properly under the rules—and so the petition was dismissed on 27 August, 2007.

On 31 October, 2007, Petitioner filed the instant petition (with fee) alleging unintentional delay under 37 C.F.R. §1.137(b), included therewith, *inter alia*, a reply in the form of an amendment, and made the statement of unintentional delay.

The availability of applications and application papers online to applicants/practitioners who diligently associate their Customer Number with the respective application(s) now provides an applicant/practitioner on-demand information as to events/transactions in an application. Thus, now if one wishes to know the progress in and/or status of an application or the accuracy of the data therein, one need only look at the file online.

Out of an abundance of caution, Petitioners always are reminded that those registered to practice *and* all others who make representations before the Office must inquire into the underlying facts of representations made to the Office and support averments with the appropriate documentation—since all owe to the Office the continuing duty to disclose.¹

STATUTES, REGULATIONS

Congress has authorized the Commissioner to "revive an application if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994).

The regulations at 37 C.F.R. §1.137(a) and (b) set forth the requirements for a Petitioner to revive a previously unavoidably or unintentionally, respectively, abandoned application.^{2, 3}

¹ See supplement of 17 June, 1999. The Patent and Trademark Office is relying on petitioner's duty of candor and good faith and accepting a statement made by Petitioner. See Changes to Patent Practice and Procedure, 62 Fed. Reg. at 53160 and 53178, 1203 Off. Gaz. Pat. Office at 88 and 103 (responses to comments 64 and 109)(applicant obligated under 37 C.F.R. §10.18 to inquire into the underlying facts and circumstances when providing statements to the Patent and Trademark Office). See specifically, the regulations at 37 C.F.R. §10.18.

² See: Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. at 53158-59 (October 10, 1997), 1203 Off. Gaz. Pat. Office at 86-87 (October 21, 1997).

³ The language of 35 U.S.C. §133 and 37 C.F.R. §1.137(a) is clear, unambiguous, and without qualification: the delay in tendering the reply to the outstanding Office action, as well as filing the first petition seeking revival, must have been unavoidable for the reply now to be accepted on petition. (Therefore, by example, an unavoidable delay in the payment of the Filing Fee might occur if a reply is shipped by the US Postal Service, but due to catastrophic accident, the delivery is not made.) Delays in responding properly raise the question whether delays are unavoidable. Where there is a question whether the delay was unavoidable, Petitioners must meet the burden of establishing that the delay was unavoidable within the meaning of 35 U.S.C. §133 and 37 C.F.R. §1.137(a). And the Petitioner must be diligent in attending to the matter. Failure to do so does not constitute the care required under Pratt, and so cannot satisfy the test for diligence and due care. (By contrast, unintentional delays are those that do not satisfy the very strict statutory and regulatory requirements of unavoidable delay, and also, by definition, are not intentional.))


CONCLUSION

The instant petition under 37 C.F.R. §1.137(b) is granted.

The instant application is released to Technology Center/AU 2611 for further processing in due course.

Petitioner may find it beneficial to view Private PAIR within a fortnight of the instant decision to ensure that the revival has been acknowledged by the Technology Center/AU in response to this decision. It is noted that all inquiries with regard to any failure of that change in status should be directed to the Technology Center/AU OPAP where that change of status must be effected—that does not occur in the Office of Petitions.

While telephone inquiries regarding this decision may be directed to the undersigned at (571) 272-3214, it is noted that all practice before the Office is in writing (see: 37 C.F.R. §1.2⁴) and the proper authority for action on any matter in this regard are the statutes (35 U.S.C.), regulations (37 C.F.R.) and the commentary on policy (MPEP). Therefore, no telephone discussion may be controlling or considered authority for Petitioner's action(s).


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⁴ The regulations at 37 C.F.R. §1.2 provide:

§1.2 Business to be transacted in writing.

All business with the Patent and Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.